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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,959	06/25/2003	Donald E. Weder	8403.927	3148

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EXAMINER

AFTERGUT, JEFF H

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 07/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/603,959

Applicant(s)

WEDER, DONALD E.

Examiner

Jeff H. Aftergut

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6-25-03</u> . | 6) <input type="checkbox"/> Other: ____. |

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Weder (US Patent 5,697,199).

At the outset, it should be pointed out that this application for the first time claimed that the base was “only” provided with adhesive on its upper surface and that the decorative or scenic objects were provided with a cohesive material upon a surface thereof as recited in claim 1. As such, the applicant is afforded an effective filing date of the filing date of this application (6-25-03). The earlier filed applications do not have support for only coating the upper surface of the base and provision of adhesive on the decorative or scenic objects. As Weder ‘199 was patented on December 16, 1997, it is available as prior art under 35 USC 102(b).

Weder ‘199 suggested that one provided a base 62 having a cohesive bonding material 64 disposed in its exposed surface (only on one side as depicted in Figures 9 and 10)). The reference taught that plural decorative objects (wrappers 44a formed from decorative sheet material 10a having various colors or designs thereon) were provided with cohesive bonding material 26a thereon. The reference to Weder ‘199 stated that the decorative objects 44a were cohesively connected to the upper surface of the base

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62 via the cohesive bonding material 64 provided thereon to create a decorative arrangement on the base.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brennan in view of Weder (US 5,697,199) and Taylor et al.

Brennan taught that it was known at the time the invention was made to provide a base sheet 14 having an adhesive bonding material 14 on one side only on the upper surface of the same. The reference suggested that those skilled in the art would have selected one or more objects including three dimensional objects and attached the same to the surface of the board via the pressure sensitive adhesive provided thereon, see paper 8 and card 10 of Figure 1 as well as column 2, lines 20-30, for example. The objects, which are adhered to the pressure sensitive adhesive on the surface, do not carry any adhesive on their surfaces. The reference suggested that the pieces of material attached to the board would have included three dimensional objects as well as puzzles and thus one skilled in the art would have understood that the board would have been capable of attaching decorative scene thereon (see column 7, lines 49-67 for the attachment of different objects to the surface of the adhesive coated base material). It should be noted that in the example the base was provided with a green color and

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that various cards and/or objects were attached to the same. One skilled in the art would have understood that such attachments would have included objects which would have provided a decorative scene and that the exact scope of such language is not clear (i.e. what kind of scene is within the scope of a "decorative scene"). The applicant is advised that while the reference provided for the attachment of the various objects and/or cards to the surface, it failed to expressly suggest that such was used for decorating and/or providing a decorative scene. However, depending upon the shape of the objects attached, the color of the same, as well as the message one wished to impart with the device, it would have certainly been obvious to one of ordinary skill in the art at the time the invention was made to provide a decorative scene with the attachment of such three dimensional objects and cards to the adhesive carrying support of Brennan. With regard to claim 2, note that the reference to Brennan suggested that one would have provided a covering over the adhesive material prior to use, see column 7, lines 68-73. The reference failed to expressly state that the three-dimensional objects being adhered onto the surface would have included an adhesive thereon. It should be noted that the reference did express that the three dimensional objects could have an adhesive coating thereon, see column 8, lines 18-32.

The reference to Weder '199 clearly expressed that those skilled in the art attaching an object to a board which had an adhesive coating on one side thereof would have known to also dispose adhesive on the surface of the objects to be joined thereto (see Figures 9 and 10). More specifically, the use of adhesive for both the board and the objects to be attached allowed one to minimize the amount of dust or debris which

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was adhered to the surface of the board by provision of the fact that the cohesive surfaces of the object and the board are compatible while other materials are not, see column 6, lines 17-23. Clearly, to provide the objects in Brennan with an adhesive thereon to provide a system with reduced dirt and debris pick up on the board (as suggested by Weder '199) would have been obvious at the time the invention was made. The combination failed to expressly teach that those skilled in the art would have disposed a design upon the board which was "decorative" (note the discussions above regarding the "decorative display" provided by Weder '199 as well as Brennan).

However, it was known in the art at the time the invention was made to dispose a miniature animal upon a pressure sensitive repositionable adhesive (i.e. the objects could be removed without pick-up of the adhesive and then repositioned upon the adhesive bearing sheet) disposed upon a board as suggested by Taylor et al. more specifically, applicant is referred to the Figure 1 where a miniature chicken was disposed upon the adhesive on the upper surface of the base bearing the adhesive thereon. Note that the reference to Brennan clearly references the use of the adhesive as a means for a board game or system for children while the reference to Taylor relates to an educational device for children which is of a board game type referred to by Brennan. Clearly, depending upon the desired design one wished to attain, one skilled in the art at the time the invention was made would have known to provide miniature pieces upon the adhesive bearing base which included miniature animals for example as evidenced by Taylor et al to provide a decorative design. It would have been obvious to one of ordinary skill in the art at the time the invention was made to

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provide a decorative design upon a base sheet bearing a releasable pressure sensitive adhesive thereon which included the use of miniature animals as suggested by Taylor et al in the process of making a decorative display as suggested by Brennan wherein not only was the upper surface of the board provided with the adhesive but also the objects being attached cohesively would have been provided with an adhesive material as suggested by Weder '199.

With respect to claim 2, note that the reference to Brennan suggested that one skilled in the art would have provided a cover for the adhesive carrying board.

Regarding claim 3, note that Taylor suggested that a miniature animal would have been placed upon the surface as part of the decoration.

Conclusion

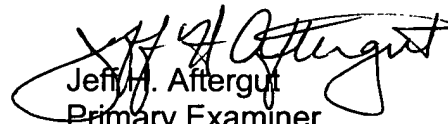
5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. E.P.989,533 suggested a bulletin board which had an adhesive bearing surface over which a protective release sheet 214 was disposed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeff H. Aftergut whose telephone number is 571-272-1212. The examiner can normally be reached on Monday-Friday 7:15-345 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on 571-272-1156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jeff M. Aftergut
Primary Examiner
Art Unit 1733

JHA
July 5, 2005